

**REMARKS**

The Applicant respectfully requests further examination and consideration in view of the arguments set forth fully below. Claims 1-54 were previously pending in this application. Within the Office Action, Claims 1-54 have been rejected. By the above amendment, Claims 1, 6, 33, 34, 38 and 39 have been amended. Accordingly, Claims 1-54 are currently pending.

**Rejections Under 35 U.S.C § 102**

Within the Office Action, Claims 1, 5, 6, 11 and 12 have been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,791,534 to Davis et al. (hereinafter "Davis"). In response to the Applicant's previous response, it is stated within the office action:

A recitation of the intended use of the claimed invention must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. A paint brush coated with paint renders a compartment it is in a "paint compartment".  
[Office Action dated November 18, 2004, page 6, lines 1-6 (Emphasis added)]. The Applicant respectfully disagrees with this rejection.

Davis discloses a painting caddy including a paint vessel with at least one paint brush holder having a brush insertion vessel. Both the paint vessel and the paint brush holder are in connection with the housing. The paint brush holder and the paint vessel are in fluid connection through a one-way valve that allows fluid flow from the brush insertion vessel to the paint reservoir vessel and blocks fluid flow in the opposite direction. Davis does not teach a paint storage apparatus having a container divided into a plurality of compartments. Davis does not teach an apparatus wherein the paint reservoir and the paint brush holder are contained in the same compartment. Further, Davis does not teach an apparatus wherein the housing is capable of containing more than one paint reservoir, and therefore more than one color or type of paint. In addition, Davis does not teach an apparatus wherein the compartments are each sealed such that paint may not be transferred between the compartments.

In contrast to the teachings of Davis, the present invention is directed to a paint storage apparatus comprising a cap, a container divided into a plurality of chambers, and a lid having a plurality of orifices. The apparatus is preferably substantially cylindrical and is uniformly formed from a homogenous material. When the lid is fixed on the container, the orifices are aligned over the chambers, with one of the plurality of orifices over each of the plurality of

chambers. Further, when the lid and the container are mated, the plurality of chambers in the container are sealed such that paint cannot be interchanged between the chambers. The cap is configured to detachably couple to the lid and prevent spillage and spoilage of paint stored within the container. In addition, the cap and the lid preferably each further comprise tabs configured to facilitate removal of the lid from the container and to facilitate removal of the cap from the lid. As described above, Davis does not teach a plurality of compartments, each sealed such that paint cannot be interchanged between the chambers. Further, Davis does not teach an apparatus wherein the paint reservoir and the paint brush holder are contained in the same compartment. Also, Davis does not teach an apparatus wherein the housing is capable of containing more than one paint reservoir, and therefore more than one color or type of paint.

In light of the above, there are structural differences between the present invention and the invention disclosed in Davis. In the present invention, each compartment is separate from any other compartment and no fluid is able to migrate between any two compartments. However, the structure of Davis forces paint to migrate from a paintbrush holder to the paint reservoir. Therefore, the painting caddy disclosed in Davis is not capable of performing the intended use of the present invention (i.e., storing multiple types and/or colors of paint in a single apparatus). The Davis invention is limited to a *single paint reservoir* and two paint brush holders. Further, it is not accurate to state that “[a] paint brush coated with paint renders a compartment it is in a ‘paint compartment.’” As taught within Davis, paint is not stored in the paint brush holder. Rather, Davis teaches that paint flows from the paint brush holder to the paint vessel through a one-way valve that blocks flow in the other direction.

The independent Claim 1 is directed to a paint storage apparatus. The paint storage apparatus of Claim 1 comprises a container divided into a plurality of paint storage compartments and a lid having a plurality of orifices, wherein when the lid is fixed on the container, the orifices are aligned over the compartments, with one of the plurality of orifices over each of the plurality of compartments. As described above, Davis does not teach a container divided into a plurality of paint storage compartments. Davis teaches only a single paint container with one or more paint brush holders for holding a single color of paint. For at least these reasons, the independent Claim 1 is allowable over the teachings of Davis.

Claim 5 is dependent upon the independent Claim 1. As discussed above, the independent Claim 1 is allowable over the teachings of Davis. Accordingly, Claim 5 is also allowable as being dependent upon an allowable base claim.

The independent Claim 6 is directed to a paint storage container. The paint storage container of Claim 6 comprises a body portion having an open upper end and forming a chamber region, one or more walls dividing the chamber region into a plurality of paint storage compartments, and a lid having a plurality of orifices configured to align over the compartments, wherein one of the plurality of orifices is over each of the plurality of compartments and wherein the lid is configured to mate with the plurality of walls so as to create a positive seal. Davis does not teach a lid configured to mate with a plurality of walls so as to create a positive seal. The upper housing taught in Davis is connected to the lower housing using a number of snap connectors. Further, as described above, Davis does not teach one or more walls dividing the chamber region into a plurality of compartments. As described above, Davis teaches only a single paint container with one or more paint brush holders for holding a single color of paint. For at least these reasons, the independent Claim 6 is allowable over the teachings of Davis.

Claims 11 and 12 are both dependent upon the independent Claim 6. As discussed above, the independent Claim 6 is allowable over the teachings of Davis. Accordingly, Claims 11 and 12 are both also allowable as being dependent upon an allowable base claim.

Within the Office Action, Claims 37, 40-43 and 45 have been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,746,345 to Crilly (hereinafter "Crilly"). In response to the Applicant's previous response, it is stated:

A recitation of the intended use of the claimed invention must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.  
[Office Action dated November 18, 2004, page 6, lines 1-5 (Emphasis added)]. The Applicant respectfully disagrees with this rejection.

Crilly discloses a paint carrier comprising a paint carrying receptacle and a paint carrying device. The paint carrying receptacle is a separate and distinct apparatus from the paint carrying device. The receptacle has two generally planar walls, an arching side wall and a bottom wall. All the walls are sealingly engaged to form a liquid-tight wedge of a cylinder whereby a multiplicity of similar receptacles may be juxtaposed to form a generally cylindrical receptacle arrangement. The paint carrying device is comprised of a side wall extending upward from the perimeter of a bottom wall and at least one irremovable and sealingly engaged dividing wall for dividing an inner volume of the device into at least two permanently separate compartments.

There are structural differences between the present invention and the invention disclosed in Crilly. In the present invention, the divided paint storage apparatus comprises a single

apparatus. However, the structure of Crilly comprises a paint carrying receptacle that is a separate and distinct apparatus from the paint carrying device.

The independent Claim 37 is directed to a divided paint storage apparatus. The divided paint storage apparatus of Claim 37 comprises integrally formed interior walls and one or more dividers coupled to the interior walls and configured to separate the apparatus into a plurality of separate chambers configured to store paint. As described above, Crilly does not teach a single apparatus to store paint with integrally formed interior walls. For at least these reasons, the independent Claim 37 is allowable over the teachings of Crilly.

Claims 40-43 and 45 are all dependent upon the independent Claim 37. As discussed above, the independent Claim 37 is allowable over the teachings of Crilly. Accordingly, Claims 40-43 and 45 are all also allowable as being dependent upon an allowable base claim.

#### **Rejections Under 35 U.S.C. § 103**

Within the Office Action, Claims 2-4 and 7-10 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Davis. The Applicant respectfully disagrees with this rejection.

Claims 2-4 are all dependent upon the independent Claim 1. As discussed above, the independent Claim 1 is allowable over the teachings of Davis. Accordingly, Claims 2-4 are all also allowable as being dependent upon an allowable base claim.

Claims 7-10 are all dependent upon the independent Claim 6. As discussed above, the independent Claim 6 is allowable over the teachings of Davis. Accordingly, Claims 7-10 are all also allowable as being dependent upon an allowable base claim.

Within the Office Action, Claims 1-12, 16-22, 24-28, 32, 33, 37 and 40-49 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,746,349 to Crilly (hereinafter "Crilly"), in view of Davis. The Applicant respectfully disagrees with this rejection.

Crilly discloses a paint carrier comprising a paint carrying receptacle and a paint carrying device. The paint carrying receptacle is a separate and distinct apparatus from the paint carrying device. The receptacle has two generally planar walls, an arching side wall and a bottom wall. All the walls are sealingly engaged to form a liquid-tight wedge of a cylinder whereby a multiplicity of similar receptacles may be juxtaposed to form a generally cylindrical receptacle arrangement. The paint carrying device is comprised of a side wall extending upward from the perimeter of a bottom wall and at least one irremovable and sealingly engaged dividing wall for dividing an inner volume of the device into at least two permanently separate compartments. Crilly does not teach an apparatus comprising a lid having a plurality of orifices, wherein when the lid is fixed

on the container, the orifices are aligned over the chambers of the container, with one of the plurality of orifices over each of the plurality of chambers.

As described above, Davis discloses a painting caddy including a paint vessel with at least one paint brush holder having a brush insertion vessel. Both the paint vessel and the paint brush holder are in connection with the housing. The paint brush holder and the paint vessel are in fluid connection through a one-way valve that allows fluid flow from the brush insertion vessel to the paint reservoir vessel and blocks fluid flow in the opposite direction. Davis does not teach a paint storage apparatus having a container divided into a plurality of compartments. Davis does not teach an apparatus wherein the paint reservoir and the paint brush holder are contained in the same compartment. Further, Davis does not teach an apparatus wherein the housing is capable of containing more than one paint reservoir, and therefore more than one color or type of paint. In addition, Davis does not teach an apparatus wherein the compartments are each sealed such that paint may not be transferred between the compartments. Davis also does not teach a lid having a plurality of orifices, with one of the plurality of orifices over each of the plurality of compartments. Davis does teach multiple openings, but all are over the same compartment. Accordingly, neither Crilly, Davis nor their combination teach a divided paint storage apparatus comprising a container divided into a plurality of separate chambers and lid having a plurality of orifices, wherein the orifices are aligned over the chambers.

In contrast to the teachings of Crilly, Davis and their combination, the apparatus of the present invention is directed to a paint storage apparatus comprising a cap, a container divided into a plurality of chambers, and a lid having a plurality of orifices. The apparatus is preferably substantially cylindrical and is uniformly formed from a homogenous material. When the lid is fixed on the container, the orifices are aligned over the chambers, with one of the plurality of orifices over each of the plurality of chambers. Further, when the lid and the container are mated, the plurality of chambers in the container are sealed such that paint cannot be interchanged between the chambers. The cap is configured to detachably couple to the lid and prevent spillage and spoilage of paint stored within the container. In addition, the cap and the lid preferably each further comprise tabs configured to facilitate removal of the lid from the container and to facilitate removal of the cap from the lid. As described above, neither Crilly, Davis nor their combination teach a divided paint storage apparatus comprising a container divided into a plurality of separate chambers and lid having a plurality of orifices, wherein the orifices are aligned over the chambers.

The independent Claim 1 is directed to a paint storage apparatus. The paint storage apparatus of Claim 1 comprises a container divided into a plurality of paint storage compartments and a lid having a plurality of orifices, wherein when the lid is fixed on the container, the orifices are aligned over the compartments, with one of the plurality of orifices over each of the plurality of compartments. As described above, neither Crilly, Davis nor their combination teach a divided paint storage apparatus comprising a container divided into a plurality of paint storage compartments and a lid having a plurality of orifices, wherein the orifices are aligned over the compartments. For at least these reasons, the independent Claim 1 is allowable over the teachings of Crilly, Davis and their combination.

Claims 2-5 are all dependent upon the independent Claim 1. As discussed above, the independent Claim 1 is allowable over the teachings of Crilly, Davis and their combination. Accordingly, Claims 2-5 are all also allowable as being dependent upon an allowable base claim.

The independent Claim 6 is directed to a paint storage container. The paint storage container of Claim 6 comprises a body portion having an open upper end and forming a chamber region, one or more walls dividing the chamber region into a plurality of paint storage compartments, and a lid having a plurality of orifices configured to align over the paint storage compartments, wherein one of the plurality of orifices is over each of the plurality of compartments and wherein the lid is configured to mate with the plurality of walls so as to create a positive seal. Davis does not teach a lid configured to mate with a plurality of walls so as to create a positive seal. The upper housing taught in Davis is connected to the lower housing using a number of snap connectors. Crilly does not teach a lid of any type. Therefore, neither Crilly, Davis nor their combination teach a divided paint storage apparatus comprising a container divided into a plurality of paint storage compartments and a lid having a plurality of orifices, wherein the orifices are aligned over the paint storage compartments. For at least these reasons, the independent Claim 6 is allowable over the teachings of Crilly, Davis and their combination.

Claims 7-12 are all dependent upon the independent Claim 6. As discussed above, the independent Claim 6 is allowable over the teachings of Crilly, Davis and their combination. Accordingly, Claims 7-12 are all also allowable as being dependent upon an allowable base claim.

The independent Claim 16 is directed to a divided paint storage apparatus. The divided paint storage apparatus of Claim 16 comprises a cup and a lid. The cup comprises integrally formed interior walls and one or more dividers coupled to the interior walls and configured to separate the cup into a plurality of separate chambers configured to store paint. The lid comprises

one or more orifices configured to align with the plurality of separate chambers and one or more guiding means configured to couple with the one or more dividers and to align the one or more orifices with the plurality of separate chambers. As described above, Davis does not teach a paint storage apparatus capable of storing multiple types or colors of paint. Further, the upper housing taught in Davis does not include one or more guiding means. The upper housing in Davis has the paint reservoir vessel and the plurality of paint brush holders integrally formed therewith. In addition, the upper housing is connected to the lower housing by a series of snap connectors. Also as described above, Crilly does not teach a lid of any type. Therefore, neither Crilly, Davis nor their combination teach a paint storage apparatus with a plurality of chambers and a lid with a plurality of orifices and a guiding means configured to couple with one or more of the dividers. For at least these reasons, the independent Claim 16 is allowable over the teachings of Crilly, Davis and their combination.

Claims 17-22, 24-28 and 32 are all dependent upon the independent Claim 16. As discussed above, the independent Claim 16 is allowable over the teachings of Crilly, Davis and their combination. Accordingly, Claims 17-22, 24-28 and 32 are all also allowable as being dependent upon an allowable base claim.

The independent Claim 33 is directed to an annular paint cup. The annular paint cup of Claim 33 comprises one or more walls contained within the annular paint cup and a lid with a plurality of orifices comprising a planar surface with a top and a bottom. The one or more walls contained within the annular paint cup divide the annular paint cup and define a plurality of paint storage cavities. It is further specified in Claim 33 that the bottom of the planar surface of the lid comprises one or more depending grooves configured to cooperatively engage with the one or more walls and align the plurality of orifices with the plurality of paint storage cavities. As described above, Davis does not teach a paint storage apparatus with a plurality of distinct compartments. Further, the upper housing taught in Davis does not include one or more depending grooves. The upper housing in Davis has the paint reservoir vessel and the plurality of paint brush holders integrally formed therewith. In addition, the upper housing is connected to the lower housing by a series of snap connectors. Also as described above, Crilly does not teach a lid of any type. Therefore, neither Crilly, Davis nor their combination teach a paint storage apparatus with a plurality of paint storage cavities and a lid with a plurality of orifices and one or more depending grooves to cooperatively engage with the plurality of walls and align the plurality of orifices with the plurality of paint storage cavities. For at least these reasons, the independent Claim 33 is allowable over the teachings of Crilly, Davis and their combination.

The independent Claim 37 is directed to a divided paint storage apparatus. The divided paint storage apparatus of Claim 37 comprises integrally formed interior walls and one or more dividers coupled to the interior walls and configured to separate the apparatus into a plurality of separate chambers configured to store paint. As described above, Davis does not teach a paint storage apparatus capable of storing multiple types or colors of paint. Further, Crilly does not disclose integrally formed interior walls. Therefore, neither Crilly, Davis nor their combination teach a divided paint storage apparatus having one or more dividers configured to separate the apparatus into a plurality of separate chambers configured to store paint. For at least these reasons, the independent Claim 37 is allowable over the teachings of Crilly, Davis and their combination.

Claims 40-49 are all dependent upon the independent Claim 37. As discussed above, the independent Claim 37 is allowable over the teachings of Crilly, Davis and their combination. Accordingly, Claims 40-49 are all also allowable as being dependent upon an allowable base claim.

Within the Office Action, Claims 13, 31, 53 and 54 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Davis, alone or in combination with Crilly, and further in view of U.S. Patent No. 5,490,608 to Hawkins (hereinafter "Hawkins"). The Applicant respectfully disagrees with this rejection.

Claim 13 is dependent upon the independent Claim 6. As discussed above, the independent Claim 6 is allowable over the teachings of Crilly, Davis and their combination. Accordingly, Claim 13 is also allowable as being dependent upon an allowable base claim.

Claim 31 is dependent upon the independent Claim 16. As discussed above, the independent Claim 16 is allowable over the teachings of Crilly, Davis and their combination. Accordingly, Claim 31 is also allowable as being dependent upon an allowable base claim.

Claims 53 and 54 are both dependent upon the independent Claim 37. As discussed above, the independent Claim 37 is allowable over the teachings of Crilly, Davis and their combination. Accordingly, Claims 53 and 54 are both also allowable as being dependent upon an allowable base claim.

Within the Office Action, Claims 14, 29, 30 and 50-52 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Davis, alone or in combination with Crilly, and further in view of Hawkins. The Applicant respectfully disagrees with this rejection.



Claim 14 is dependent upon the independent Claim 6. As discussed above, the independent Claim 6 is allowable over the teachings of Crilly, Davis and their combination. Accordingly, Claim 14 is also allowable as being dependent upon an allowable base claim.

Claims 29 and 30 are both dependent upon the independent Claim 16. As discussed above, the independent Claim 16 is allowable over the teachings of Crilly, Davis and their combination. Accordingly, Claims 29 and 30 are both also allowable as being dependent upon an allowable base claim.

Claims 50-52 are all dependent upon the independent Claim 37. As discussed above, the independent Claim 37 is allowable over the teachings of Crilly, Davis and their combination. Accordingly, Claims 50-52 are all also allowable as being dependent upon an allowable base claim.

Within the Office Action, Claims 15, 23 and 34-36 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Davis, alone or in combination with Crilly, and further in view of U.S. Patent No. 2,016,488 to Eckhaus (hereinafter "Eckhaus"). The Applicant respectfully disagrees with this rejection.

Eckhaus discloses a vacuum container for materials and product which are to be maintained out of contact with the atmosphere and at substantially sub-atmospheric pressure before actual consumption. The vacuum container contains a plurality of compartments which are sealed in an air-tight matter from each other and from the exterior. Each compartment may independently be opened. Internal partitioning walls forming the compartments and a cover and base elements attach in an air-tight fashion to side walls of the container. The internal partitioning walls and covering base elements are connected to each other such that their permanency is not affected by the independent opening of any one compartment. Each compartment is provided with a means to permit the opening thereof by substantially complete removal of its side formed by the cover element and without affecting the permanent attachment. Further, the pieces are attached such that it will permit the convenient vacuum application to the container after filling and before final sealing. Eckhaus does not teach a container means for retaining paint. Eckhaus merely teaches a container used for the storage of shredded, granular, or pulverized products, such as foodstuff, coffee and tobacco. In addition, Eckhaus does not teach a lid comprising a plurality of groove means configured to cooperatively engage with inner walls. Moreover, Eckhaus does not teach a lid with a plurality of orifices configured to align with the plurality of storage cavities.

Claim 15 is dependent upon the independent Claim 6. As discussed above, the independent Claim 6 is allowable over the teachings of Crilly, Davis and their combination. Accordingly, Claim 15 is also allowable as being dependent upon an allowable base claim.

Claim 23 is dependent upon the independent Claim 16. As discussed above, the independent Claim 16 is allowable over the teachings of Crilly, Davis and their combination. Accordingly, Claim 23 is also allowable as being dependent upon an allowable base claim.

The independent Claim 34 is directed to a divided paint cup. The divided paint cup of Claim 34 comprises a container means and a lid. The container means comprises a main chamber divided by one or more inner walls and a plurality of storage cavities defined by the enclosed space between the inner walls and the main chamber and configured for receiving and retaining paint. The lid comprises an annular base portion and an annular wall joined to the annular base portion, a plurality of groove means coupled to the annular base portion and configured to cooperatively engage with the one or more inner walls, and a plurality of orifices configured to align with the plurality of storage cavities when the plurality of groove means are cooperatively engaged with the one or more inner walls. As described above, Davis does not teach a divided paint cup capable of storing multiple types or colors of paint. Further, the upper housing taught in Davis does not include one or more groove means. The upper housing in Davis has the paint reservoir vessel and the plurality of paint brush holders integrally formed therewith. In addition, the upper housing is connected to the lower housing by a series of snap connectors. Also as described above, Crilly does not teach a lid of any type. Further, Eckhaus does not teach a container means for retaining paint. Eckhaus does not teach a lid comprising a plurality of groove means configured to cooperatively engage with inner walls. Moreover, Eckhaus does not teach a lid with a plurality of orifices configured to align with the plurality of storage cavities. Therefore, neither Crilly, Davis, Eckhaus, nor their combination teach a divided paint cup with a plurality of storage cavities and a lid with a plurality of orifices configured to align with the plurality of storage cavities when the plurality of groove means are cooperatively engaged with the plurality of inner walls. For at least these reasons, the independent Claim 34 is allowable over the teachings of Crilly, Davis, Eckhaus and their combination.

Claims 35 and 36 are both dependent upon the independent Claim 34. As discussed above, the independent Claim 34 is allowable over the teachings of Crilly, Davis, Eckhaus and their combination. Accordingly, Claims 35 and 36 are both also allowable as being dependent upon an allowable base claim.

Within the Office Action, Claims 38 and 39 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Davis. The Applicant respectfully disagrees with this rejection.

Specifically, it is stated within the office action that "[t]o employ thermoforming to provide the molded container of Davis et al. would not appear to distinguish any new and unobvious result, as official notice is taken that thermoforming molded containers was well known in the art at the time applicant's device was derived." Applicant respectfully disagrees that thermoforming would have been obvious at the time the present invention was derived. Davis does not teach how the invention is made. Applicant requests Examiner to provide prior art specifying the use of thermoforming in the fashion presently presented.

**Rejections Under 35 U.S.C. § 112**

Within the Office Action, Claims 6-15 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. By the above amendments, Claim 6 has been amended to change "plurality of" to "one or more". Accordingly, lines 7-8 of Claim 6 now clearly have antecedent basis and consistency with line 3. Therefore, Claims 6-15 are now in a condition for allowance.

For the reasons given above, Applicant respectfully submits that the Claims 1-54 are in a condition for allowance, and allowance at an early date would be appreciated. Should the Examiner have any questions or comments, the Examiner is encouraged to call the undersigned at (408) 530-9700 to discuss the same so that any outstanding issues can be expeditiously resolved.

Respectfully submitted,  
HAVERSTOCK & OWENS LLP

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By: Jonathan O. Owens  
Jonathan O. Owens  
Reg. No.: 37,902  
Attorney for Applicant

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